

1 James D. Petrucci (Bar No. 115175)
2 THE PETRUZZI LAW FIRM
3 4900 Woodway, Suite 745
4 Houston, TX 77056
5 Telephone: (713) 840-9993
6 Facsimile: (713) 877-9100
jdpetrucci@gmail.com

7 Attorneys for Plaintiff

8 Marc H. Cohen (Bar No. 168773)
9 Lien K. Dang (Bar No. 254221)
KIRKLAND & ELLIS LLP
3330 Hillview Avenue
Palo Alto, CA 94304
Telephone: (650) 859-7000
Facsimile: (650) 859-7500
marc.cohen@kirkland.com
lien.dang@kirkland.com

10 Attorneys for Defendants

11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN FRANCISCO DIVISION

DR. SHAUN L. W. SAMUELS,

11 Plaintiff,

12 vs.

13 TRIVASCULAR, INC., ET AL.

14 Defendants.

CASE NO. 3:13-CV-02261-EMC

15 **STIPULATION AND
[PROPOSED] ORDER AND
FINAL JUDGMENT OF NON-
INFRINGEMENT OF THE '575
PATENT**

Judge: Hon. Edward M. Chen

16 TRIVASCULAR, INC.,

17 Counter-Claimant,

18 vs.

19 DR. SHAUN L. W. SAMUELS,

20 Counter-Defendant.

21
22 WHEREAS, Plaintiff Dr. Shaun L.W. Samuels ("Samuels") and Defendant TriVascular, Inc.
23 ("TriVascular"), and individual Defendants Michael A. Chobotov, Robert G. Whirley, and Joseph
24 W. Humphrey ("Individual Defendants") ("the Parties") stipulate and move for entry of judgment of
25 non-infringement under all claims of U.S. Patent No. 6,007,575 ("the '575 patent") as to the
26 Defendants based on the Court's Claim Construction Order (Dkt. No. 92);

1 WHEREAS, entering judgment of non-infringement now will allow the parties to forego
 2 further litigation in this Court of the '575 patent, while preserving Samuels's right to appeal the
 3 Court's Claim Construction Order (Dkt. No. 92);

4 WHEREAS, Civil L.R. 54-1(a) requires that Bill of Costs be served and filed no later than 14
 5 days after entry of judgment;

6 WHEREAS, Civil L.R. 54-5 requires that a Motion for Fees be served and filed no later than
 7 14 days after entry of judgment; and

8 WHEREAS, Samuels intends to appeal the Court's forthcoming entry of a judgment of non-
 9 infringement based on this stipulation.

10 IT IS HEREBY STIPULATED AND AGREED by the Parties, subject to the approval of the
 11 Court, as follows:

12 1. This is a patent infringement action brought by Samuels against TriVascular, Michael
 13 A. Chobotov, Robert G. Whirley, and Joseph W. Humphrey. Samuels filed this patent litigation
 14 action against TriVascular on May 17, 2013. *See* Dkt. No. 1. Samuels filed a Second Amended
 15 Complaint on August 13, 2015 adding the Individual Defendants. *See* Dkt. No. 77. The Defendant
 16 TriVascular filed an Answer, Affirmative Defenses and Counterclaims to Plaintiff's Second
 17 Amended Complaint on August 27, 2015 (Dkt. No. 78), and the Individual Defendants filed their
 18 Answer and Affirmative Defenses on August 27, 2015 (Dkt. No. 79). TriVascular's pending
 19 counterclaims are patent counterclaims of non-infringement (First Counterclaim) and invalidity
 20 (Second Counterclaim), as well as counterclaims for breach of contract and promissory estoppel
 21 (Third, Fourth and Fifth Counterclaims). Plaintiff has asserted infringement of claims 1-7, 9-11, 13-
 22 17, 19-21, and 23-24 of the '575.

23 2. On November 12, 2015, this Court construed certain claim terms found in the '575
 24 patent. (Claim Construction Order, Dkt. No. 92).

1 3. The Parties disputed the construction of the term “means for injecting an inflation
 2 material into said cuff to inflate it “ and “means for inflating the cuff with inflation material” of
 3 claims 1, 14 and 23 of the ’575 patent as follows:

Claim Term	Samuels	Defendants
means for injecting an inflation material into said cuff to inflate it [claim1]	<p>This is a means-plus-function element governed by 35 U.S.C. §112, ¶ 6.</p> <p>Function: The function is injecting an inflation material into said cuff to inflate it.</p> <p>Structure: The corresponding structure is an inflation device, such as the kind of syringe shown in Figs. 1 and 9a-9c (71, 117) containing an inflation material; inflation tubing (61, 115) with a mating end (63) that opens a valve by separating opposing leaflets (51, 53) that are in an inflation port (39, 123) to inflate the cuff.</p>	<p>This is a means-plus-function limitation governed by 35 U.S.C. §112, ¶ 6.</p> <p>Function: The function is injecting an inflation material into said cuff to inflate it.</p> <p>Structure: The corresponding structure is an inflation syringe of the kind shown in Figs. 1 and 9a-9c (71, 117) containing an inflation material; inflation tubing (61, 115) with a mating end (63) that opens a valve by separating opposing leaflets (51, 53) that are in an inflation port (39, 123) to inflate the cuff.</p>

Claim Term	Samuels	Defendants
means for inflating the cuff with inflation material [claim 14]	<p>This is a means-plus-function element governed by 35 U.S.C. §112, ¶ 6.</p> <p>Function: The function is inflating the cuff/plurality of cuffs with inflation material.</p>	<p>This is a means-plus-function limitation governed by 35 U.S.C. §112, ¶ 6.</p> <p>Function: The function is inflating the cuff/plurality of cuffs with inflation material.</p>
means for inflating the plurality of cuffs with inflation material [claim 23]	<p>Structure: The corresponding structure is an inflation device, such as the kind of syringe shown in Figs. 1 and 9a-9c (71, 117) and inflation tubing</p>	<p>Structure: The corresponding structure is an inflation syringe of the kind shown in Figs. 1 and 9a-9c (71, 117) containing</p>

1		(61, 115)	an inflation material; inflation tubing (61, 115) with a mating end (63) that opens a valve by separating opposing leaflets (51, 53) that are in an inflation port (39, 123) to inflate the cuff with the inflation material.
2			

7 4. The Parties also disputed the construction of the term “valve” of claims 1, 14 and 23
8 of the ’575 patent as follows:

9 Claim Term	10 Samuels	11 Defendants
12 a valve integral [with the 13 inflatable cuff, cl. 1] [with 14 said inflation port, cl. 14] 15 [with one of the plurality 16 of cuffs, cl. 23] for 17 permitting entry of the 18 inflation material . . . and 19 thereafter sealing said 20 cuff to prevent deflation	21 Any structure that affects 22 fluid flow, formed or 23 combined as a unit with the 24 cuff, and is capable of not 25 stopping inflation material 26 from entering the cuff from 27 the means for injecting and 28 capable of stopping inflation material from leaving the cuff after the injection material has entered the cuff to prevent deflation.	29 a device built-in to the 30 [cuff] [inflation port] [one 31 of the cuffs] that has a 32 movable part (such as 33 leaflets) that opens to 34 permit entry of the 35 inflation material and 36 thereafter closes to seal the 37 cuff to prevent deflation. 38 This construction does not 39 cover inflation tubing 40 inserted into an inflation 41 port with an interference 42 fit.
43 Claim Term	44 Samuels	45 Defendants
46 a valve	47 Any structure that affects 48 fluid flow	49 See above
50 Claim Term	51 Samuels	52 Defendants
53 “for permitting entry of 54 the inflation material 55 from the means for 56 injecting and thereafter 57 sealing said cuff to 58 prevent deflation”	59 Capable of not stopping 60 inflation material from 61 entering the cuff from the 62 means for injecting and 63 capable of stopping 64 inflation material from 65 leaving the cuff after the 66 injection material has 67 entered to cuff to prevent 68 deflation.	69 See above

1 5. The Parties also disputed the construction of the term “inflatable and deflatable cuff,”
 2 “a cuff,” and “a plurality of cuffs” of claims 1, 14 and 23 of the ’575 patent as follows:

Claim Term	Samuels	Defendants
inflatable and deflatable cuff of generally hollow cylindrical continuation (sic. configuration)	Cuff of generally hollow cylindrical configuration (per Claim Construction Order)	a band-like structure that has an inner surface and outer surface creating an inflatable chamber that may be inflated by filling the chamber with fluid or deflated by allowing the fluid to leave in ordinary use

10 11 6. The Parties now stipulate that, given the Court’s construction of the term “means for
 12 injecting an inflation material into said cuff to inflate it” as set forth in the Court’s Claim
 13 Construction Order (Dkt. No. 92) as well as the statement at page 7 of the cuff 17 having to be
 14 “inflated and deflated by means of a valve, indicated generally at 37 in FIGS 4a and 4b, which is
 15 integral with inflation port 39 of cuff 17” in the ’575 Patent, Samuels cannot prove infringement of
 16 claims 1-7, 9-11, and 13 of the ’575 patent by the Defendants.

17 18 7. The Parties now stipulate that, given the Court’s construction of the term “means for
 19 inflating the cuff with inflation material” as set forth in the Court’s Claim Construction Order (Dkt.
 20 No. 92) as well as the statement at page 7 of the cuff 17 having to be “inflated and deflated by means
 21 of a valve, indicated generally at 37 in FIGS 4a and 4b, which is integral with inflation port 39 of
 22 cuff 17” in the ’575 Patent Samuels cannot prove infringement of claims 14-17, 19-21, and 23-24 of
 23 the ’575 patent by the Defendants.

24 25 8. The Parties further stipulate that, given the Court’s construction of the term “a valve
 26 integral with the inflatable cuff for permitting entry of the inflation material from the means for
 27 injecting and thereafter sealing said cuff to prevent deflation” as set forth in the Court’s Claim
 28 Construction Order (Dkt. No. 92), Samuels cannot prove infringement of claims 1-7, 9-11 and 13 of

1 the '575 patent by the Defendants.

2 9. The Parties further stipulate that, given the Court's construction of the term "a valve
3 integral with the inflatable cuff for permitting entry of the inflation material from the means for
4 inflating and thereafter sealing said cuff to prevent deflation" as set forth in the Court's Claim
5 Construction Order (Dkt. No. 92), Samuels cannot prove infringement of claims 14-17, 19-21, and
6 23-24 of the '575 patent by the Defendants.
7

8 10. The Parties further stipulate that, given the Court's construction of the term "a valve"
9 as set forth in the Court's Claim Construction Order (Dkt. No. 92), Samuels cannot prove
10 infringement of claims 1-7, 9-11, 13-17, 19-21, and 23-24 of the '575 patent by the Defendants.
11

12 11. The Parties further stipulate that, given the Court's construction of the term "for
13 permitting entry of the inflation material from the means for injecting and thereafter sealing said cuff
14 to prevent deflation" as set forth in the Court's Claim Construction Order (Dkt. No. 92), Samuels
15 cannot prove infringement of claims 1-7, 9-11 and 13 of the '575 patent by the Defendants.
16

17 12. The Parties further stipulate that, given the Court's construction of the term "for
18 permitting entry of the inflation material from the means for inflating and thereafter sealing said cuff
19 to prevent deflation" as set forth in the Court's Claim Construction Order (Dkt. No. 92), Samuels
20 cannot prove infringement of claims 14-17, 19-21, and 23-24 of the '575 patent by the Defendants.
21

22 13. The Parties further stipulate that, given the Court's construction of the term
23 "inflatable and deflatable cuff of generally hollow cylindrical continuation [sic configuration]" as set
24 forth in the Court's Claim Construction Order (Dkt. No. 92), including that "an 'inflatable cuff' must
25 mean that the entire structure is inflated" as set forth in footnote 9 of Dkt. No. 92, Samuels cannot
26 prove infringement of claims 1-7, 9-11, and 13 of the '575 patent by the Defendants.
27

28 14. The Parties further stipulate that the Court enter judgment of non-infringement as to
the '575 patent to conserve judicial resources and to avoid the time and expense of further discovery
29

1 and motion practice related to the '575 patent. Plaintiff is not asserting any other claims of the '575
 2 patent other than claims 1-7, 9-11, 13-17, 19-21, and 23-24. Upon entry of such judgment, Samuels
 3 intends to appeal the Court's forthcoming entry of judgment of non-infringement based on this
 4 stipulation.

5 15. The Parties further stipulate that Rule 54(b) authorizes a district court to "direct entry
 6 of a final judgment as to one or more, but fewer than all, claims ... if the court expressly determines
 7 that there is no just reason for delay." Fed. R. Civ. P. 54(b). In view of the Court's claim
 8 construction, as described above, and because the non-infringement issue is separable from the
 9 remaining counterclaims, in the interest of sound judicial administration, there is no just reason for
 10 delaying the entry of final judgment of non-infringement as to the '575 patent, and final judgment of
 11 non-infringement, subject to the Court's approval, is hereby entered pursuant to Fed. R. Civ. P.
 12 54(b).

13 16. As to TriVascular's Second through Fifth Counterclaims, the Parties further stipulate
 14 that the counterclaims, subject to the Court's approval, are hereby stayed pending Samuels's appeal
 15 of the judgment of non-infringement as to the '575 patent. Defendants are preserving their rights
 16 and by entering into this stipulation Defendants do not waive the right to assert non-infringement
 17 under any claim limitations or claim constructions if the case is remanded. The stay shall be lifted
 18 after the appellate court's issuance of the mandate regarding Samuels's appeal of the Court's
 19 judgment, or if Samuels later chooses to abandon an appeal, the stay shall be lifted after Samuels
 20 provides notice that he is abandoning the appeal.

21 17. The Parties further stipulate that in order to promote judicial efficiency and to
 22 conserve litigation costs, the deadlines for the Bill of Costs and Motion for Fees (including Motion
 23 for Fees pursuant to 35 U.S.C. § 285) concerning the non-infringement judgment that is the subject
 24 of this Stipulation be delayed until 21 days after the appellate court's issuance of the mandate

1 regarding Samuels's appeal of the Court's judgment, or if Samuels later chooses to abandon an
 2 appeal, the deadlines be delayed until 21 days after Samuels provides notice that he is abandoning
 3 the appeal.

4 **IT IS SO AGREED AND STIPULATED:**

5 DATED: December 15, 2015

6 Respectfully submitted,

7 /s/ Marc H. Cohen

8
 9 Marc H. Cohen
 Lien K. Dang
 10 KIRKLAND & ELLIS LLP
 11 3330 Hillview Avenue
 12 Palo Alto, CA 94304
 13 Telephone: (650) 859-7000
 14 Facsimile: (650) 859-7500
 15 marc.cohen@kirkland.com
 16 lien.dang@kirkland.com

17
 18 Attorneys for Defendants
 19 TriVascular, Inc., Michael A. Chobotov,
 20 Robert G. Whirley, and Joseph W.
 21 Humphrey

22 Respectfully submitted,

23 /s/ James D. Petrucci

24 James D. Petrucci (SBN 115175)
 25 THE PETRUZZI LAW FIRM
 26 4900 Woodway, Suite 745
 27 Houston, TX 77056
 28 Telephone: (713) 840-9993
 Facsimile: (713) 877-9100
 jdpetrucci@gmail.com

29 Martin J. Siegel
 30 700 Louisiana, Suite 2300
 31 Houston, TX 77002
 32 Telephone: (713) 226-8566
 33 Martin@Siegefirms.com

34
 35 Attorneys for Plaintiff
 36 DR. SHAUN L.W. SAMUELS

37 **ATTESTATION OF CONCURRENCE IN FILING**

38
 39 I, James D. Petrucci, am the ECF User whose identification and password are being used to
 40 file this Joint Stipulation. In compliance with Local Rule 5-1(i)(3), I hereby attest that Marc H.
 41 Cohen of Kirkland & Ellis, LLP has concurred in this filing.

42 /s/ James D. Petrucci

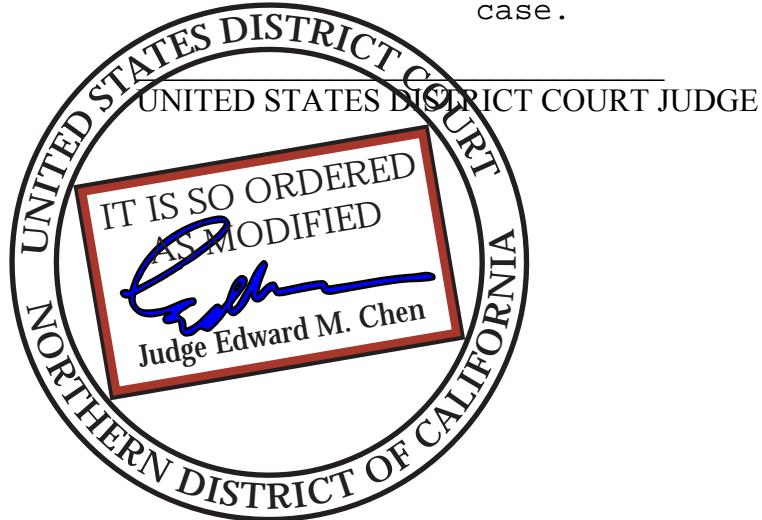
43 James D. Petrucci (SBN 115175)
 44 THE PETRUZZI LAW FIRM
 45 4900 Woodway, Suite 745
 46 Houston, TX 77056
 47 Telephone: (713) 840-9993

1 Facsimile: (713) 877-9100
2 jdpetruzzi@gmail.com

3 Attorneys for Plaintiff
4 DR. SHAUN L.W. SAMUELS

5 **PURSUANT TO STIPULATION, IT IS SO ORDERED.** The Clerk of the Court
6 is directed to close this
7 case.

8 DATED: 12/17/15



1 **CERTIFICATE OF SERVICE**

2 I hereby certify that on December 15, 2015 that a copy of the foregoing document is being
3 electronically filed with the Clerk of the United States District Court for the Northern District of
4 California by using the CM/ECF system, which will send notice of such filing to all counsel of
5 record.

6 Dated: December 15, 2015

7 */s/ James D. Petrucci*

8 James D. Petrucci (SBN 115175)
9 THE PETRUZZI LAW FIRM
10 4900 Woodway, Suite 745
11 Houston, TX 77056
12 Telephone: (713) 840-9993
13 Facsimile: (713) 877-9100
14 jdpetrucci@gmail.com

15 Attorneys for Plaintiff
16 DR. SHAUN L.W. SAMUELS